Supreme Court, U.S.
FILED
JAN 3 1995
OFFICE OF THE CLERK

No. 94-811

In The

Supreme Court of the United States

October Term, 1994

MELVIN WALLSHEIN,

Petitioner,

v.

CABLESTRAND CORPORATION

and

ALLAN B. WEISS,

Respondents.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

CHARLES H. THOMAS
CISLO & THOMAS
4201 Long Beach Boulevard
Suite 405
Long Beach, California 90807
(310) 595-8422

Counsel for Respondents Cablestrand Corporation and Allan B. Weiss

COCKLE LAW BRIEF PRINTING CO., (800) 225-6964
OR CALL COLLECT (402) 342-2831

QUESTIONS PRESENTED

The questions presented in the petition are argumentative, replete with misstatements of fact and law, and repetitious. The only question which could have been stated is:

1. Did the Court of Appeals, by affirming the District Court's determination of failure of Petitioner to carry the burden of proving infringement of his patents, so far depart from the accepted and usual course of judicial proceedings, or sanction such a departure by the District Court, as to call for an exercise of the Supreme Court's power of supervision?

TABLE OF CONTENTS

Page

QUESTIONS PRESENTED i

STATEMENT OF THE CASE 1

SUMMARY OF THE ARGUMENT 3

ARGUMENT 4

PETITIONER'S ATTACK UPON THE CAFC DECISION OF MARCH 8, 1993 IS UNTIMELY 4

THE DISTRICT COURT PROPERLY CONSIDERED THE EVIDENCE WITH RESPECT TO ALL ISSUES AND ENTERED FINDINGS IN ACCORDANCE WITH THE FEDERAL RULES OF CIVIL PROCEDURE 6

The District Court Correctly Found, Based on the Evidence, That There Was No Infringement 6

The Finding That the Accused Wire Does Not Have a "Lumen" Is Not Clearly Erroneous 12

THE ALLEGATIONS OF THE EXISTENCE OF PURPORTED "BIASES" BY THE DISTRICT COURT WERE NOT TIMELY RAISED IN THE APPEAL BELOW 15

THE ALLEGATIONS OF DENIAL OF DUE PROCESS BY THE DISTRICT COURT ARE SPECIOUS AND REPLETE WITH FALSE REPRESENTATIONS 15

THE ALLEGED "BIASES" ATTRIBUTED TO BOTH THE DISTRICT AND APPELLATE COURTS ARE TOTAL FABRICATION 23

CONCLUSION 24

TABLE OF AUTHORITIES

Page

CASES

Allen Bradley Co. v. Local Union No. 3, I.B.E.W., 145 F. 2d 215 (CA 2 1944), reversed on other grounds 325 U.S. 797, 65 S. Ct. 1533 23

Black Diamond Coal Co. v. Excelsior Coal Co., 156 U.S. 611, 39 L. Ed. 553 (1895) 8

Brown Paper Mill Co., Inc. v. Irwin, 134 F. 2d 337 (CA 8 1943) 23

Dunbar v. Meyers, 94 U.S. 399, 49 L. Ed. 110, 25 S. Ct. 697 7

FCC v. League of Women Voters of California et al, 468 U.S. 364, 82 L. Ed. 2d 278 4

Federal Trade Commission v. Minneapolis – Honeywell – Regulator Co., 344 U.S. 206, 73 S. Ct. 245, 97 L. Ed. 2455 (1952) 4

Gaddis v. Calgon Corp., 506 F. 2d 880, 184 USPQ 449 (CA 5) 7

General Talking Pictures Corp. v. Western Elec. Co., 304 U.S. 175, 58 S. Ct. 849, 82 L. Ed. 1273 (1938) 10

Johnson v. IVAC Corp., 885 F. 2d 1574, 12 USPQ 2d 1382 (CAFC 1989) 8

National Labor Relations Bd. v. Pittsburgh Steamship Co., 340 U.S. 498, 71 S. Ct. 453, 95 L. Ed. 479 (1951) 10

Peterson, Lighterage & Towing Corp. v. New York Central R. Co., 126 F. 2d 992 (CA 2 1942) 23

Prouty v. Ruggles, 41 U.S. 336, 10 L. Ed. 985 (1842) 8

TABLE OF AUTHORITIES – Continued

Page

Rice v. Sioux City Memorial Parks Cemetery, 349 U.S. 70, 75 S. Ct. 614, 99 L. Ed. 897 (1955) 11

Texas Instruments, Inc. v. United States International Trade Commission, 988 F. 2d 1165, 26 USPQ 2d 1018 (1993) 9

Unique Concepts, Inc. v. Brown, 939 F. 2d 1558, 19 USPQ 2d 1500 (1991) 9

United States v. Forness, 125 F. 2d 928 (CA 2 1942) cert. den. 316 U.S. 694, 62 S. Ct. 1293, 86 L. Ed. 1764 23

Young v. Murphy, 9 Fed Rules Serv. 52a.11, Case 2, 1946 23

FEDERAL RULES

Rules of the Supreme Court of the United States

Rule 10 S. Ct. 10

Rule 13 S. Ct. 4

Rules of the Court of Appeals for the Federal Circuit

Rule 28 CAFC 2

Federal Rules of Civil Procedure

Rule 52 FRCP 1, 17, 22

Rule 59 FRCP 18, 19

Rule 60 FRCP 19

TABLE OF AUTHORITIES – Continued

Page

LOCAL RULES OF THE U.S. DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

Rule 9.5 USDC CD CA 20

Rule 13.6 USDC CD CA 2

STATEMENT OF THE CASE

Petitioner alleges that there was such a deviation from the Federal Rules of Civil Procedure by the District Court that he was denied due process. Yet Petitioner fails to relate specifically how the actions of the District Court of which he complains violated any passage of the Federal Rules of Civil Procedure. Petitioner further alleges that the Court of Appeals for the Federal Circuit (CAFC) denied him due process by applying the "clearly erroneous" standard to the findings of the District Court and that this was somehow contrary to the Federal Rules of Civil Procedure. He makes this assertion despite the fact that Rule 52(a) of the Federal Rules of Civil Procedure specifically states that findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. Moreover, Petitioner ignores the fact that the CAFC based its affirmation of the District Court on its own interpretation de novo of the critical claim limitation of "partially separating turns."

The Petition for Writ of Certiorari totally ignores the great weight of evidence against Petitioner that was presented at trial in the District Court and which was reproduced in the Appendix on appeal and referred to extensively in the briefs submitted on appeal to the CAFC. It is therefore appropriate to refer specifically herein to matters in evidence and statements in the proceedings as reproduced in the Appendix and considered by the CAFC in reaching its judgment of May 24, 1994.

References to specific pages of the CAFC Appendix are in the form: (Apx.___). References to the Trial Transcript specify the separate volumes of the transcript taken in chronological order at trial as Volumes I, I', II, III and IV. References to pages and line numbers are to the numbered pages and lines within the volume cited. These references to the Trial Record are in the following form: (T. R. Vol. ___, p. ___, l. ___, Apx. ___). Also, since the trial was a bench trial the direct testimony of each party's case in chief was presented in the form of a narrative declaration in accordance with Rule 13.6 of the Local Rules of the U.S. District Court for the Central District of California. References to pages and lines of this narrative testimony is in the form of (Narr. ___, p.___, l.___, Apx.___). In addition to the Appendix page designations required by CAFC Rule 28(e), references to Exhibits include the trial exhibit numbers and are in the following form: (Exh. ___, Apx. ___).

The critical issues which were before the District Court for trial were:

1. Whether or not Cablestrand's wire infringed the patents in suit;

2. Whether or not the patents in suit were valid;

3. Whether or not Wallshein was barred by either laches or estoppel in his claims against Cablestrand;

4. Whether or not Allan B. Weiss had any personal liability in connection with the manufacture of the wire; and

5. Whether or not Wallshein was barred by either laches or estoppel from recovery against Weiss personally.

SUMMARY OF THE ARGUMENT

This petition is untimely with respect to any alleged denial of due process for vacation of the District Court order of May 29, 1992, since Petitioner failed to timely file a Petition for Certiorari when the Appellate Court vacated that judgment on March 8, 1993.

Petitioner's allegations of a denial of due process are sheer fabrication. The plain truth is that Petitioner received full and fair consideration of his allegations in the courts below. The Petition for Certiorari in this case is filled with outrageous misstatements of fact and unsupported allegations of fictitious "biases" which purportedly lead to a denial of due process in the litigation below. Petitioner offers no facts, but only unsupported allegations as to the existence of "complex subject matter" and "heavy docket" biases. Petitioner's argument totally ignores the fact that the evidence considered by the District Court weighed heavily against him. Neither the District Court nor the CAFC violated the Federal Rules of Civil Procedure. Petitioner simply failed to carry his burden of proof, but is now dissatisfied with the result.

ARGUMENT

PETITIONER'S ATTACK UPON THE CAFC DECISION OF MARCH 8, 1993 IS UNTIMELY

In his petition Petitioner attacked the portion of the CAFC decision of March 8, 1993, which vacated the judgment of the District Court entered on May 29, 1992 (Petition, pages 16-17). Rule 13 of the Rules of the Supreme Court provides that a petition for Writ of Certiorari to review a judgment of a United Stated Court of Appeals must be filed within ninety days after the entry of the judgment.

The period within which an appeal must be taken of a Petition for Certiorari filed begins to run anew only when the lower Court changes matters of substance or resolves a genuine ambiguity in a judgment previously rendered and not when a judgment previously entered has been reentered or revised in an immaterial way; *FCC v. League of Women Voters of California et al.*, 468 U.S. 364 at 373, 82 L. Ed. 2d 278; *Federal Trade Commission v. Minneapolis - Honeywell - Regulator Co.*, 344 U.S. 206, 73 S. Ct. 245, 97 L. Ed. 2455 (1952). Here there was no revision whatsoever of the first CAFC judgment of March 8, 1993 in the second CAFC judgment of May 24, 1994. Petitioner's petition for a review of the CAFC decision of March 8, 1993, comes more than a year and a half after that decision was entered, and is woefully untimely as to that decision.

At page 17 of his Petition Petitioner argues that the action of the CAFC in vacating the District Court Order of May 29, 1992, was *ultra vires*. This assertion now directly contradicts his own prior statements made in his

own appeal brief in his cross appeal of that District Court Order. In that brief Petitioner stated:

> "The statutory basis for jurisdiction of this Court to hear the appeal and cross appeal is 28 USC Section 1291 and 28 USC Section 1295(a)(1).
>
> The present appeal is timely, having been filed within 30 days of the date of the decision of the U.S. District Court entered on May 29, 1992, as required by Federal Rule of Appellate Procedure 4(a)(1). The present appeal is from a final order or a final judgment that disposes of all claims of liability with respect to all parties in both Civil Action No. CV 84-4219 and Civil Action No. CV 89-4329."

Petitioner then went on to request that the Lower Court be affirmed in Action I and reversed in Action II.

Petitioner now approaches this court with the disingenuous argument that the action of the CAFC in vacating the order, which he had acknowledged as being final and appealable and in which he requested partial affirmation, was *ultra vires*.

In footnote 9 of the Petition Petitioner asserts that the CAFC decision to vacate the District Court's holding of its intent to find for Petitioner was "contrary to the law." Petitioner provides no illumination as to "the law" to which he refers. However, this point is moot since Petitioner's petition is untimely as to the CAFC judgment of March 8, 1993.

THE DISTRICT COURT PROPERLY CONSIDERED THE EVIDENCE WITH RESPECT TO ALL ISSUES AND ENTERED FINDINGS IN ACCORDANCE WITH THE FEDERAL RULES OF CIVIL PROCEDURE

The District Court Correctly Found, Based on the Evidence, That There Was No Infringement

The accused wire does not have "partially separating turns" as required by the patent claims. The claims of Petitioner's patents require coiled strands made from a material sufficiently elastic to permit bending of the archwire by selectively and at least partially separating adjacent turns. Fig. 5 of both patents illustrates the degree of separation contemplated. With reference to Fig. 5 of the reissue patent drawings (Exh. 1, Apx. 81) it can be seen that where the archwire 10 is bent there is a significant partial separation between the adjacent turns of the helically wound filaments 11, 12 and 13. It is possible for this separation to occur because at the center of the wire coils there is a lumen. As a result there is little friction between the central core wire, if one is utilized, and the overwound filaments which would prevent the longitudinal separation of adjacent turns.

The patents discuss the creation of a separation between turns sufficiently large so that the protection of tissues in the mouth and the prevention of food particles from entering into the spaces in the wire are of concern (Exh. 1, col. 4, l. 54-59, Apx. 74). The patents discuss this extent of separation as being on the order of the thickness of the fastening wires 36 (Exh. 1, col. 6, l. 62-68, Apx. 75), which is on the order of .009 to .010 inches (Narr. Dr. Garth Reid, p. 7, l. 23-27, Apx. 14).

The patents state that the localized separation of originally abutting turns, as depicted in Fig. 5, allows the wire to bend significantly without permanently being deformed and without loss of resiliency when mounted in orthodontic brackets (Exh. 1, col. 5, l. 64 - col. 6, l. 11, Apx. 75).

Even when the accused wire is flexed to the extent that it acquires a permanent deformation, there is no separation of turns which is visible to the naked eye, and no separation of turns which has any clinical significance to an orthodontist (Narr. Dr. Garth Reid, p. 8, l. 13-20 and p. 14, l. 7-25, Apx. 15 and 17). There is no separation of adjacent turns in the bent wire manufactured by the Respondent Cablestrand which would allow food particles to become trapped between the adjacent turns, as contemplated in Petitioner's patents (Exh. 1 at col. 4, l. 55-59, Apx. 74). Likewise, there is no partial separation which would even approach the thickness of the fastening wires that hold the archwire onto the bracket, as described in the patents (Exh. 1, col. 6, l. 62-68, Apx. 75).

No contrary evidence at trial was presented. Instead, Petitioner attempted to show through photographs taken with an electron microscope that the adjacent helically overwound strands of the accused wire had "at least partially separating adjacent turns".

It is a fundamental axiom of patent law that an omission in the accused device of an ingredient or element contained in the complainant's patent avoids an infringement; *Dunbar v. Meyers*, 94 U.S. 399, 49 L. Ed. 110, 25 S. Ct. 697; and *Gaddis v. Calgon Corp.*, 506 F. 2d 880, 184 USPQ 449 (CA 5). Omission of even one element or

ingredient of a combination covered by any claim of a patent avoids any charge of infringement based upon that claim, *Prouty v. Ruggles*, 41 U.S. 336, 10 L. Ed. 985 (1842); *Black Diamond Coal Co. v. Excelsior Coal Co.*, 156 U.S. 611, 39 L. Ed. 553 (1895).

The District Court properly held in its Findings of Fact and Conclusion of Law that the accused wire did not meet the claim requirement for partial separation of turns (Finding of Fact VI and Conclusion of Law IV).

In its prior decision in *Johnson v. IVAC Corp.*, 885 F. 2d 1574, 12 USPQ 2d 1382 (CAFC 1989) the CAFC had previously rejected a contention by a patentee that evidence of microscopic structural features could create literal infringement where those microscopic features played no part in the function of the accused device. In this litigation the CAFC specifically addressed the separating turns limitation and the findings of the District Court that the Respondent Cablestrand's wire did not meet that limitation.

Petitioner falsely alleges that "the CAFC proceeded to "dispose" of the appeal on a totally new theory which was conceived by the CAFC but had no basis whatsoever in the trial record" (Petition, page 26). In fact the CAFC specifically held that it was reviewing the construction given the claims *de novo*. The CAFC correctly observed that Petitioner's proposed claim construction was that the phrase "at least partially separating" included any degree of separation, no matter how small or microscopic. The CAFC disagreed with Petitioner and quite accurately held that Petitioner's proposed claim construction would render meaningless this express limitation in the claims.

Petitioner's argument that the strands of the Respondent Cablestrand's wire will separate (when bent sufficiently to inelastically deform) is a characteristic of all prior art stranded wire. It was a blatant misrepresentation for Petitioner to state at trial that what he illustrated in Fig. 5 and discussed extensively throughout his patents, and which appears as the penultimate limitation of his claims was intended to merely state a physical characteristic of all prior art coaxial stranded wire (e.g., Exh. 420, p. 183, Apx. 173).

The CAFC followed its own precedents in *Unique Concepts, Inc. v. Brown*, 939 F. 2d 1558, 19 USPQ 2d 1500 (1991) and *Texas Instruments, Inc. v. United States International Trade Commission*, 988 F. 2d 1165, 26 USPQ 2d 1018 (1993) in which it had rejected a patentee's proffered claim construction because it would render the disputed claim language mere surplusage. The CAFC therefore correctly construed the claims as requiring the amount of separation between adjacent turns upon bending of the arch wire to be of a magnitude somewhat greater than microscopic. The CAFC properly held, based upon its own precedents, that all of the limitations of the claim must be considered meaningful. It properly rejected Petitioner's argument (adopted for purposes of trial) that the phrase "at least partially separating turns" was merely a truism describing a phenomenon dictated by the laws of physics and which occurs in every prior art wire and that this phrase should be treated as mere surplusage. The CAFC properly concluded that the separations between adjacent turns must be of some magnitude greater than microscopic.

The holding of an absence of "at least partially separating turns" was dispositive of the issue of infringement, and indeed of the entire case. The CAFC stated that, during oral argument before it, Petitioner's counsel had agreed that an affirmation on the issue of non-infringement would render moot the issues of laches and the Respondent Weiss' personal liability.

An issue of fact is not "important" for purposes of considering a Grant of Certiorari under U.S. Supreme Court Rule 10. Normally, the United States Supreme Court will not grant certiorari to review a decision that turns solely upon an analysis of facts, or to determine whether the evidence supports a judgment of a district court or an administrative agency. As to such issues, the courts of appeals are generally the courts of last resort. As held in *National Labor Relations Bd. v. Pittsburgh Steamship Co.*, 340 U.S. 498, 71 S. Ct. 453, 95 L. Ed. 479 (1951):

> "This is not the place to review a conflict of evidence nor to reverse a Court of Appeals because were we in its place we would find the record tilting one way rather than the other, though fair-minded judges could find it tilting either way. It is not for us to invite review by this Court of decisions turning solely on evaluation of testimony where on a conscientious consideration of the entire record a Court of Appeals under the new dispensation finds the Board's order unsubstantiated."

Likewise, this Court has held in *General Talking Pictures Corp. v. Western Elec. Co.*, 304 U.S. 175, 58 S. Ct. 849, 82 L. Ed. 1273 (1938) that granting of a Writ of Certiorari

would not be warranted merely to review the evidence or inferences drawn from it.

Furthermore, this Court held in *Rice v. Sioux City Memorial Parks Cemetery*, 349 U.S. 70, 75 S. Ct. 614, 99 L. Ed. 897 (1955):

> "A writ of certiorari will not be granted by the Supreme Court except in cases involving principles the settlement of which is important to the public, as distinguished from that of the parties . . . "

The CAFC did indeed find that the determination by the District Court with respect to the issue of "partially separating turns" was dispositive of the entire litigation, since without that claim element there could be no infringement by any party. Thus, even if the District Court had limited its findings to only that issue, its judgment would properly have been upheld. If there had been any "heavy docket bias" or "complex issues bias" as Petitioner alleges, the District Court would surely have gone no further in its findings. Quite to the contrary, however, the District Court fully considered each and every one of the critical issues in this litigation, previously enumerated herein, and entered findings of fact and conclusions of law with respect to all of them.

Petitioner falsely alleges that the District Court did not independently evaluate the evidence or render its judgment on the evidence. These allegations are without any support in the record and are totally untrue.

The Finding That the Accused Wire Does Not Have a "Lumen" Is Not Clearly Erroneous

Another claim feature which is absent from the accused wire is a plurality of coiled strands wound in the form of a coiled wire having a lumen extending therethrough. In the patents in suit the term "lumen" is repeatedly referred to as a "passage" 18 within which a mandrel 60 may or may not be left subsequent to manufacture (Exh. 1, col. 3, l. 57-66, and col. 4, l. 18-22, Apx. 74). In his patents Petitioner stated that the feature of being able to leave the mandrel 60 inside the archwire or, at the option of the user, remove it prior to use allowed one to affect the characteristics of the wire (Exh. 1, col. 7, l. 59 - col. 8, l. 3, Apx. 76). The patents state that "where most of the work involves bends in small spaces, the mandrel 60 is advantageously removed so as to increase the working range of the archwire" (Exh 1, col. 7, l. 68 to col. 8, l. 3, Apx. 76).

At trial Petitioner sought to broaden the scope of his claims by redefining the term "lumen". His new definitions were especially created for purposes of trial and appear nowhere in the patents in suit nor in the prior art. The District Court properly found Petitioner's evidence that the accused wire met this claim limitation to be unconvincing. The District Court, in its findings of fact and conclusions of law, defined the term "lumen" as utilized in the patents in suit and held that the accused wire does not have a lumen (Conclusions of Law III).

The patents also state that the ability to remove the mandrel allows one to alter the characteristics of flexibility, springiness, and rigidity by selectively twisting

the ends of the wire in opposite directions (with the mandrel removed) to reduce the diameter of the lumen as desired by the user (Exh. 1, col. 8, l. 21-42, Apx. 76). The lumen diameter can be reduced to a substantially zero diameter (Exh. 1, col. 9, l. 17-22, Apx. 77). By substantially eliminating the lumen lateral flexibility and longitudinal springiness are sacrificed in favor of more rigidity (Exh. 1, col. 8, l. 39-42, Apx. 76).

At trial numerous samples of promotional material used by distributors of the Respondent Cablestrand's orthodontic archwire were presented (Exhs. 768-799 and 900-927, Apx. 516-525, 707-778, and 1650-1706). Nowhere in any of this promotional material was there any claim of a capability of removal of a center core strand from the surrounding overwound strands.

Petitioner argues at page 24 of his petition that the accused wire infringed because his witness, Dr. Thurow, in court was able to "effortlessly" withdraw the core wire from the accused wire. However, it is uncontroverted that Dr. Thurow spent approximately fifteen minutes of time manipulating and partially unraveling the strands of a short section of the accused wire in order to be able to accomplish this "effortless" task (T.R. Vol. II, p. 4, l. 17-22, Apx. 55). On cross examination Dr. Thurow testified, when asked if there was any reason for removing the Cablestrand wire, that he had only become aware of the possibility within the last few weeks and had not applied it clinically (Appendix to Petition for Certiorari, page 44a).

Petitioner hypocritically chastises the District Court for not explaining why the courtroom demonstration of

Dr. Thurow was given little or no weight and for not commenting in its findings on this test. However, although Petitioner now claims that Dr. Thurow's mastery of this manipulation of the wire strands was exceedingly important, he did not consider it at all important at the trial. Quite to the contrary, at trial when Petitioner himself was unable to extract the core wire from the surrounding strands of the accused wire Petitioner's counsel stated:

> "However, I just want to make it very clear, your honor, that this test and this whole concept of withdrawing the core from the strand is totally, totally irrelevant to the patent." (T.R. vol. I', p. 5, l. 18-21, Apx. 51B).

Petitioner also alleges in his Petition that the District Court ignored purported "critical facts" that required a finding of infringement. Petitioner's statements are both false and misleading. In his brief he attributed to one of Plaintiff's expert witnesses, Dr. Larry McKnight, a statement that certain test results submitted to the District Court were false. This is absolutely untrue. Furthermore, at page 23 of his Petition Petitioner does not even quote Dr. McKnight, but rather again attributes to him statements that he never made.

Furthermore, whether or not the accused wire had a lumen is inconsequential, since infringement could not be found because the accused wire did not meet the "partially separating turns" claim limitations. Neither the testimony of Dr. McKnight to which Petitioner refers, nor

the courtroom demonstration of Dr. Thurow had anything whatsoever to do with the findings regarding partially separating strands, which was totally dispositive of the entire case.

THE ALLEGATIONS OF THE EXISTENCE OF PURPORTED "BIASES" BY THE DISTRICT COURT WERE NOT TIMELY RAISED IN THE APPEAL BELOW

On certiorari to review a decision of a Federal Court of Appeals which affirmed a District Court ruling a question is not properly brought before the United States Supreme Court where it was not raised on appeal to the Court of Appeals. In his appeal to the CAFC Petitioner did not even raise the purported "heavy docket" bias and the purported "complex subject matter" bias. These allegations have now appeared for the first time in the present Petition for Certiorari. They were totally absent from his brief and oral arguments in his appeal to the CAFC, as well as his petition for rehearing to the CAFC. It was only after receiving an adverse decision of the CAFC that Petitioner raised these heretofore unexpressed and recently fabricated allegations. Quite obviously these allegations are directly attributable to the adverse judgment of the CAFC rather than any actual defect in the manner of conduct of the prior proceedings by either the District Court or the CAFC.

THE ALLEGATIONS OF DENIAL OF DUE PROCESS BY THE DISTRICT COURT ARE SPECIOUS AND REPLETE WITH FALSE REPRESENTATIONS

As one of his allegations of denial of due process Petitioner faults the District Court for taking more than a

year from the conclusion of trial until entering its Notice of Intended Judgment and Order Thereon (Petition, footnote 12, page 9). This statement is false. The presentation of evidence was concluded somewhat after 5:00 PM on Friday, May 3, 1991. The District Court, with the concurrence of Petitioner's counsel, requested closing arguments to be submitted in writing and established a briefing schedule for closing arguments according to which Petitioner's rebuttal would have been due on May 22, 1991. Petitioner's counsel, subsequently filed a stipulated request for an extension of this date to July 8, 1991. This was the date on or about which Petitioner filed his rebuttal closing argument and at which time trial was concluded.

Thus, Petitioner's statement that the District Court did not render its initial Notice of Intended Judgment of May 29, 1992 for more than a year after trial is blatantly false.

Furthermore, Petitioner's objection to the lapse of time, from July 8, 1991 to May 29, 1992, at which time the District Court issued its initial Notice of Intended Judgment is most curious. Petitioner waited more than six years before bringing any charge of infringement against the Respondent Cablestrand and more than eleven years before bringing any charge of infringement against the Respondent Weiss. Moreover, in his petition Petitioner states that the issues were complex. Nevertheless, he faults the District Court for taking a number of months to consider these complex issues before issuing the Notice of Intended Judgment.

Petitioner also stated in his petition that more than two years elapsed before the District Court complied with the CAFC's mandate to issue findings of fact and conclusions of law under Rule 52(a) of the Federal Rules of Civil Procedure (Petition, Footnote 12, page 9). The CAFC issued this mandate on March 8, 1993. The District Court complied with that mandate with its findings of fact and conclusions of law on May 28, 1993. Thus, the District Court complied with the mandate within about two and a half months, not more than two years as Petitioner falsely alleges.

Petitioner further alleges, without authority, that the District Court's partial reversal of its own judgment is totally contrary to law. This is absolutely untrue. Rule 52(b) of the Federal Rules of Civil Procedure specifically provides that when findings of fact are made in actions tried by the court without a jury, the question of the sufficiency of the evidence to support the findings may *thereafter* be raised whether or not the party raising the question has made in the District Court an objection to such findings or has made a motion to amend them or a motion for judgment.

Respondents in their appeal from the initial Notice of Intended Judgment, and Petitioner in his cross-appeal from that same order, both urged the District Court to reverse itself on the respective portions of that order which did not favor them. Both parties filed motions in the District Court urging the District Court to accept copies of the appeal briefs which the parties had previously submitted to the CAFC prior to its decision of March 8, 1993. In Petitioner's motion to the District Court, filed on or about March 30, 1993, urging the Court

to accept briefs of the parties and the Appendix, Petitioner's counsel stated:

> "the parties have expended much time, effort, and money in preparing the foregoing briefs and Appendix to set forth their best arguments concerning the key liability issues in this litigation. It is believed that the briefs and such additional materials may be of interest and assistance in the preparation of the findings and conclusions."

Thus, Petitioner's argument that the reversal by the District Court of its own Judgment I "is totally contrary to law", not only lacks any legal authority, but is utterly hypocritical, since Petitioner specifically urged the Court to reverse that portion of the Notice of Intended Judgment that did not favor him.

Petitioner's argument that the District Court's action was "ultra vires" is utterly without merit. Petitioner alleges that there was a ten-day time limit within which the District Court could have reversed its initial determination. Petitioner cites no precedent to support this argument. Petitioner instead refers to Rule 59 of the Federal Rules of Civil Procedure. However, that Rule relates only to a court ordering a new trial within ten days after entry of judgment (FRCP Rule 59(a)-(d)) and with motions to alter or amend a judgment (FRCP Rule 59(e)). Petitioner made no motion for a new trial within the ten-day time limit provided in Rule 59(b), nor at any other time, and the Court did not order a new trial at any time. There was no motion by any party for alteration or amendment of the judgment.

While Rule 59 of the Federal Rules of Civil Procedure has no applicability in this case, Rule 60(a) does. As explained by the District Court in the Introduction to its Findings of Fact and Conclusions of Law:

> "On or about May 29, 1992, this Court issued a Notice of Intended Judgment along with an Order for additional briefing on the issue of damages. Upon receipt of the written memorandum of points and authorities the Court intended to prepare and file its complete Findings of Fact and Conclusions of Law and its Judgment. The Notice of Entry stamp under F.R.C.P. Rule 77(d) was erroneously placed by the clerk."

The District Court never intended for its Notice of Intended Judgment and Order Thereon to be a final, appealable judgment, although due to a clerical error it was indicated as such. The District Court properly corrected this error on its own initiative in its Findings of Fact and Conclusions of Law, which Rule 60(a) provides can be done at any time. As provided by Rule 60(a) of the Federal Rules of Civil Procedure this correction was delayed until the remand since, without leave of the Appellate Court, the District Court could not have made this correction while both Petitioner's and Respondents' appeals of the order of May 29, 1992, were still pending. The District Court's actions were entirely in accordance with Rule 60(a) which was applicable in this case and which covers corrective measures to be taken to remedy clerical mistakes, such as occurred here.

Since the order of May 29, 1992, was never intended to constitute a final judgment, the District Court was free

to consider further its ultimate judgment and revise its intended holding if warranted. In any event the CAFC properly vacated the order of May 29, 1992, so that order was null and void and of no further force or effect. Petitioner cites no specific authority to support his assertion at page 20 of the Petition that the action of the District Court was an unwarranted reversal and totally contrary to law. Indeed, there are no authorities to support Petitioner's position.

In addition to attacking the substance of the findings of fact and conclusions of law filed by the District Court on May 28, 1993, Petitioner maintains that the fact that the District Court chose to adopt some of the Respondent's proposed findings which the applicable Local Rules of the District Court require to be filed somehow taints these findings. This is simply not the law.

The U.S. District Court for the Central District of California, like many of the Federal District Courts, has implemented a specific rule, Local Rule 9.5, that *requires* the parties to submit proposed findings of fact and conclusion of law prior to trial. The purpose of this rule is not to require the parties to file needless papers which, having been prepared with great time, effort and expense to the litigants, the District Court should thereupon ignore. Quite to the contrary, the purpose of this rule is to allow each party to best present the concise facts it proposes to prove and a concise statement of the applicable law as it relates to those facts as an aid to the District Court in reaching its own findings.

Contrary to Petitioner's assertion, there was nothing sinister or unusual in the methodology adopted by the

District Court in examining the proposed findings and conclusions of the parties and in picking and choosing from among them those which the court deemed to have been adequately proven. *Indeed, that is the entire purpose behind requiring the litigants to file proposed findings and conclusions.*

Petitioner falsely asserts that the District Court performed a "wholesale adoption of the prevailing parties proposed findings". Quite to the contrary, the District Court quite evidently selected only those proposed findings and conclusions which it believed were supported by the evidence and which stated the applicable law. Indeed, the District Court declined to adopt any one of the Respondents' proposed findings and conclusions concerning the issue of validity of the patents in suit, which was tried by the District Court.

At the close of evidence at trial The District Court in instructing counsel regarding their closing statements, specifically called their attention to the proposed findings of fact and conclusion of law that the parties had previously filed prior to trial. The District Court directed the parties to:

> "review the findings of fact and conclusions of law to determine whether it is current as far as your position is concerned. And I strongly urge that as far as the findings of fact and conclusions of law are concerned, let's stress brevity and simplicity." (T.R. Vol. IV, p. 196, l. 1-5).

At the time Petitioner voiced no objection to the intent of the District Court to render brief, simple findings and use the parties' proposed findings. Petitioner

only made such objections after his own findings were not adopted.

Petitioner goes on to state that by adopting some, but certainly not all, of the findings of fact and conclusions of law proposed by Respondents, the District Court was taking "the path of least resistance." This is totally illogical, since the District Court could just as easily have adopted Petitioner's proposed findings had it found in Petitioner's favor and if the evidence had supported such findings.

Petitioner then makes the absurd statement that adoption of the proposed findings of fact and conclusions of law would dispose of the matter while minimizing the probability of appeal. This is ridiculous since Petitioner had previously appealed when only a portion of the initial Notice of Intended Judgment was against him. Petitioner then makes the further false statement that by adopting the proposed findings the District Court would not have to resolve complex issues in the case. However, the District Court did indeed resolve each and every one of the salient issues in the litigation.

Petitioner states that the findings did not contain any reference to the evidence proffered at trial or to the trial transcript. He apparently objects to the fact that the findings do not cite specific exhibits or specific pages of the trial transcript testimony. However, there is no requirement whatsoever that this should be done.

Quite to the contrary, and as stated in the notes of the Advisory Committee on Rules with respect to FRCP Rule 52, the judge need only make brief, definite, pertinent findings and conclusions upon the contested matter;

there is no necessity for over-elaboration of detail or particularization of facts. *United States v. Forness*, 125 F. 2d 928, (CA 2 1942) cert. den. 316 U.S. 694, 62 S. Ct. 1293, 86 L. Ed. 1764; *Peterson, Lighterage & Towing Corp. v. New York Central R. Co.*, 126 F. 2d 992 (CA 2 1942); *Brown Paper Mill Co., Inc. v. Irwin*, 134 F. 2d 337 (CA 8 1943); *Allen Bradley Co. v. Local Union No. 3, I.B.E.W.*, 145 F. 2d 215 (CA 2 1944), reversed on other grounds 325 U.S. 797, 65 S. Ct. 1533; and *Young v. Murphy*, 9 Fed Rules Serv. 52a.11, Case 2, 1946. In raising this objection to the findings the only authority cited by Petitioner is an essay of Sir Francis Bacon from the year 1597. Clearly, such a citation has no relevance to the Federal Rules of Civil Procedure.

Petitioner alleges "irregular" actions of the District Court, yet has shown no action by the District Court that was inconsistent with the Federal Rules of Civil Procedure.

THE ALLEGED "BIASES" ATTRIBUTED TO BOTH THE DISTRICT AND APPELLATE COURTS ARE TOTAL FABRICATION

While Petitioner now attributes to the District Court a concocted "complex subject matter bias" and "heavy docket bias" he did not raise any such purported issues in his appeal to the CAFC. Interestingly, in Footnote 28, he states that District Courts have been known to voice their opinions, even on the record, that they "dislike" technically complex cases, most frequently, patent cases. However, he apparently found no such statement on the record by this District Court, since he makes no reference to the record of this case in this connection. Indeed, Petitioner has shown not the slightest indication that the

judgment of either the District Court or the Appellate Court was motivated by any bias.

Petitioner's purported "biases" are totally illusory and intended to distract this Court from the plain and simple fact that the District Court did not consider Petitioner's witnesses, other evidence, and arguments to be credible. The CAFC properly concurred that indeed Petitioner had failed to prove the threshold issue of infringement, which was totally dispositive of the case.

CONCLUSION

Petitioner's Petition for Certiorari is not worthy of consideration by this Court. It is nothing more than a frivolous attempt to foist upon this Court further consideration of Petitioner's meritless claims which he has thus far failed to prove. Nothing has been shown to warrant an exercise of this Court's power of supervision. Petitioner is merely seeking yet another tribunal before which to press claims which are unsupported by the relevant evidence.

For all of the foregoing reasons Respondents urge the Court to summarily deny Petitioner's Petition for Certiorari.

Date: January 3, 1995

Respectfully submitted,

CHARLES H. THOMAS
Attorney for Respondents
Cablestrand Corporation
and
Allan B. Weiss

CISLO & THOMAS
Suite 405
4201 Long Beach Boulevard
Long Beach, California 90807-2007
(310) 595-8422